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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/510,568

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Tapio Korpinen

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EXAMINER

ZHU, WEIPING

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

03/31/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/510,568	Applicant(s) KORPINEN, TAPIO	
	Examiner WEIPING ZHU	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 22, 2009 has been entered.

Status of Claims

2. Claims 20-40 are currently under examination wherein no claim has been amended in applicant's amendment filed on January 22, 2009.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 20-37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atrens et al (WO 9529207 A1) in view of Chiba et al. (US 5,447,561).

With respect to claim 20, Atrens et al ('207 A1) disclose a artificial patination material comprising at least a copper salt precipitated with an alkali metal hydroxide and a metal compound (lines 1-6, page 7). The phrase "the formed sludge filtered for forming a precipitate paste, wherein the reaction between the raw material and the alkali

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metal hydroxide was stopped with water, the precipitates dispersed with powder mixing and an addition of a dispersing agent” in claim 20 is a product-by-process limitation. Even through product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. Atrens et al (‘207 A1) disclose a patination material (line 10, page 8 to line 20, page 9), which reasonably appears to be only slightly different than the respective claimed product in the product-by-process claim. A rejection based on section 103 of the status is eminently fair and acceptable. See MPEP 2113.

Atrens et al (‘207 A1) do not disclose adding an oxidative agent and carbon to the solution as claimed. Chiba et al. (‘561) disclose using iron oxide and carbon as pigments (col. 4, lines 30-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add iron oxide and carbon in the patination material of Atrens et al (‘207 A1) as disclosed by Chiba et al. (‘561) in order to achieve desired coloration of the patination material of Atrens et al (‘207 A1) as disclosed by Chiba et al. (‘561) (col. 4, lines 30-52).

With respect to claims 21, 26, 27 and 37, Atrens et al (‘207 A1) disclose that an inorganic silicate is used as a binder in an amount of 100g to 1,000g of the reaction produce per one liter of the binder (lines 5-20, page 9). Atrens et al (‘207 A1) do not disclose the claimed features of the instant claims 21, 26, 27 and 37. However, it is well held that discovering an optimum value of a result-effective variable involves only routine skill in the art. In re Boesch, 617, F.2d 272, 205 USPQ 215 (CCPA 1980). In the

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instant case, the type and the amount of the binder used, which in combination will determine the percentage of the dry matter in the patination material as claimed in the instant claim 26 and the coverage of the patination material particles by the binder as claimed in the instant claim 27, are result-effective variable, because it would directly affect the adhesion of the formulation of the patination material to the substrate as disclosed by Atrens et al ('207 A1) (lines 5-20, page 9). Therefore it would have been obvious to one skilled in the art to have optimized the selection of the binder and its amount in the process of Atrens et al ('207 A1) in view of Chiba et al. ('561) in order to achieve the desired adhesion. See MPEP 2144.05 II.

With respect to claims 22 and 23, Atrens et al ('207 A1) disclose that the copper salt is copper sulfate (lines 1-6, page 7).

With respect to claim 24 and 25, Atrens et al ('207 A1) do not disclose the claimed features. However, it has been well held where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical process, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), MPEP 2112.01 [R-3] I. In the instant case, the claimed and Atrens et al ('207 A1) in view of Chiba et al. ('561)'s patination material are identical or substantially identical in composition and are produced by identical or substantially identical processes, therefore a prima facie case of obviousness exists. The same amount of posnjakite and the same grain size of the patination material particles would

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be expected in the patination material of Atrens et al ('207 A1) in view of Chiba et al. ('561) as in the claimed patination material.

With respect to claims 28 and 29, Atrens et al ('207 A1) disclose that an iron compound is used as a color pigment (lines 16-18, page 8).

With respect to claims 30-36, Chiba et al. ('561) disclose that iron compound, manganese compound, copper compound, chromium compound, magnesium compound and carbon can be used as color pigments (col. 4, lines 30-52). The teaching of Chiba et al. ('561) reads on the specific compounds as claimed in the instant claims 30, 33 and 35 because Chiba et al. ('561) disclose the pigment compounds in general terms which would include the claimed specific compounds. It would have been obvious to one skilled in the art to have select the claimed compounds within the general compounds disclosed by Chiba et al. ('561) with expected success, because Chiba et al. ('561) disclose the same utility over the entire disclosed compounds. See MPEP 2144.05 I.

With respect to claim 40, Atrens et al ('207 A1) disclose that the amount of color pigment (i.e. iron sulfate) is 1-5 % by weight of the copper sulfate (Examples 1-3, page 10). The range overlaps the claimed range. A prima facie case of obviousness exists. See MPEP 2144.05 I.

4. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atrens et al ('207 A1) in view of Chiba et al. ('561) as applied to claim 20 above and further in view of Priggemeyer et al. (US 6,176,905 B1).

With respect to claims 38 and 39, Atrens et al ('207 A1) in view of Chiba et al. ('561) do not teach the claimed features. Priggemeyer et al. ('905 B1) disclose that the reaction solution for producing patina can be stored at ambient temperature over a period of several months (col. 3, lines 5-7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to store the patination material of Atrens et al ('207 A1) in view of Chiba et al. ('561) at ambient temperature over a period of several months as disclosed by Priggemeyer et al. ('905 B1) without any detrimental ageing effects as disclosed by Priggemeyer et al. ('905 B1) (col. 3, lines 5-7).

Response to Arguments

5. The applicant's arguments filed on January 22, 2009 have been fully considered but they are not persuasive.

First, the applicant argues that the examiner's conclusive statement in the non-final Office action dated August 3, 2007 and the final Office action dated May 7, 2008 that It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Atrens et al ('207 A1) and Chiba et al. ('561) is insufficient to establish a prima facie case of obviousness. In response, the examiner notes that the combination of Atrens et al ('207 A1) and Chiba et al. ('561) with a proper motivation as stated in the Office actions renders the claimed feature of the oxidative agent and carbon obvious to one of ordinary skill in the art.

Second, the applicant argues that examiner's conclusive statement in the final Office action dated May 7, 2008 that both iron oxide and carbon of Chiba et al. ('561) would inherently be as reactive as the claimed oxidative agent and carbon does not establish it is clear that the subject matter is necessary present in Chiba et al. ('561), and that ordinary skilled artisan would recognize it. In response, the examiner notes as stated in the non-final Office action dated August 3, 2007 that Chiba et al. ('561) disclose using iron oxide and carbon as pigments (col. 4, lines 30-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add iron oxide and carbon in the patination material of Atrens et al ('207 A1) as disclosed by Chiba et al. ('561) in order to achieve desired coloration of the patination material of Atrens et al ('207 A1) as disclosed by Chiba et al. ('561) (col. 4, lines 30-52). Furthermore, as stated in the final Office action dated May 7, 2008 that both iron oxide and carbon of Chiba et al. ('561) meet the claim limitations in the instant claim 1. Therefore, the examiner's statement that both iron oxide and carbon of Chiba et al. ('561), when added to the patination composition of Atrens et al ('207 A1), would inherently be as reactive as the claimed oxidative agent and carbon in the final Office action dated May 7, 2008 is proper and maintained.

Conclusions

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the

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application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WZ

3/12/2009

/George Wyszomierski/
Primary Examiner
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